



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,384	01/22/2004	Jui-Kung Wu	3624-0148P	2427

2292 7590 08/02/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,384

Applicant(s)

WU ET AL.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-11,13-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,7,8,10,13,14,17,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 1, 3, 5, 9, 11, 15, 16, 18, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1755

This action is in response to applicants' amendment of 20 June 2005. The amendment to the specification has overcome the objections to the disclosure. The amendments to the claims have overcome the 35 USC 112 rejections and the art rejections. The terminal disclaimer filed on 20 June 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of application 10/711,002 has been reviewed and is accepted. The terminal disclaimer has been recorded. Applicant's arguments with respect to the remaining objections and rejections have been fully considered but they are not persuasive.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no teaching of the subject matter of the claims 8, 14, 16 and 21. There is no teaching of reducing gas in general. The wording in the specification implies the reducing gas is limited to $H_2(8\%)/N_2(92\%)$. There is no teaching in the specification that the chelating agent is any organic compound that releases at least one of inflammable gas and reducing gas when decomposed by heating. The specification only teaches the chelating agent is urea or ammonium organic salts that release at least one of inflammable gas and reducing gas when decomposed by heating.

Applicants state that the paragraph bridging pages 7 and 8 provide antecedent basis for the claimed "reducing gas". This paragraph states "in a reducing gas H_2/N_2 (8%:92%)". This wording implies the gas is H_2/N_2 (8%:92%), not that sintering can occur in any reducing gas, such as H_2/N_2 (8%:92%). Thus this argument is not convincing. With respect to the subject matter of claim 16, the teachings on page 9 does not provide antecedent basis for a chelating agent that release at least one of inflammable gas and reducing gas when decomposed by heating

Art Unit: 1755

since it teaches urea or ammonium oxalate release both an inflammable gas and reducing gas.

The objections are maintained.

Claims 8, 14 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The claims teach the reducing gas reduced the Re ion, while the specification teaches the gas reduces the cerium ion (pg. 7, lines 20-22; pg. 9, lines 8-10 and pg. 11, lines 1-2). This discrepancy needs to be corrected.

The amendments to the claims did not correct this discrepancy.

Claims 1, 4, 10 and 17 are objected to because of the following informalities: The formula should be rewritten as $(\text{Tb}_{3-x-y}\text{Ce}_x\text{Re}_y)\text{Al}_{5-z}\text{Si}_z\text{O}_{12}$. Appropriate correction is required.

Claims 4, 7, 10, 13, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite since the metal compounds used to make the fluorescent material do not include silicon compounds.

Claim 1 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

Claims 3, 5, 9, 11, 15, 16, 18, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1755

Claims 4, 10 and 17 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph and objections set forth in this Office action.

Claims 7, 8, 13, 14, 20 and 21 are would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

These claims are allowable for the reasons given in the previous action.

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

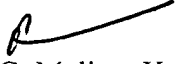
The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1755

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 29, 2005



C. Melissa Koslow
Primary Examiner
Tech. Center 1700